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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,874	12/01/2000	David C. Turner	VTN-518	4049

7590 02/17/2004

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EXAMINER

SIMONE, CATHERINE A

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/727,874

Applicant(s)

TURNER ET AL.

Examiner

Catherine Simone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Repeated Rejections

1. The 35 U.S.C. 103 rejection of claim 6 over Wu et al. is repeated for the reasons previously set forth in Paper #9, Pages 2-3, Paragraph #6.
2. The 35 U.S.C. 103 rejection of claims 7-11 over Wu et al. in view of Vanderlann et al. is repeated for the reasons previously set forth in Paper #9, Page 3, Paragraph #7.
3. The 35 U.S.C. 103 rejection of claims 12 and 13 over Wu et al. in view of Maiden et al. is repeated for the reasons previously set forth in Paper #9, Pages 3-5, Paragraph #8.
4. The 35 U.S.C. 103 rejection of claims 14 and 15 over Wu et al. in view of Kunzler et al. is repeated for the reasons previously set forth in Paper #9, Pages 5-6, Paragraph #9.

Response to Arguments

5. Applicant's arguments filed November 18, 2003 have been fully considered but they are not persuasive. Applicant argues that "With respect to periodicity Wu discloses that the holes "are preferably spaced so that the center-to-center distance between the holes is between from 5 to 300 microns, more preferably between from 50-250 microns and most preferably between from 100 to 175 microns" (column 5, lines 39-43), all of which are much further spaced than the less than about 3 μm recited in claim 6." However, it is to be pointed out that the optimum range for the periodicity would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end results as shown by Wu et al. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention

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was made to have provided the periodic structures on the surface of the lens in Wu et al. with a periodicity of less than about 3 μm , since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art absence of showing unexpected results. *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980).

Applicant further argues that “Wu discloses a surface roughness less than 10 microns RMS, less than 3 microns RMS and less than 0.5 microns RMS. When converted to nanometers these ranges are less than 1000 nanometers, less than 300 nanometers and less than 50 nanometers, over 10 to 250 times greater than the amplitude recited in the present application.” However, it is to be pointed out that claim 6 in the present application recites “an amplitude of less than about 4 nm RMS”. Wu et al. discloses a surface roughness less than 10 microns RMS (10000 nm RMS), more preferably less than 3 microns RMS (3000 nm RMS) and most preferably less than 0.5 microns RMS (500 nm RMS), which overlaps with the claimed range of less than about 4 nm RMS. Therefore, a *prima facie* case of obviousness exists, since the claimed ranges “overlap or lie inside ranges disclosed by the prior art.” *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976).

Furthermore, Applicant argues that “Unlike Wu, the present invention relates to the elimination of periodic defects which would be visible to the eye. Wu teaches the introduction of visible surface defects to a lens. There is no teaching or suggestion in Wu regarding the periodicity or amplitude limits needed to insure that any defects which are present do not generate coherent scattering or produce visible tool marks. This is particularly important for coated lenses, as “the swelling of the coating magnifies these surface defects.” Page 1, lines 24-

25. If anything, Wu teaches away from the present invention, as Wu discloses introducing highly visible defects onto a lens surface.” In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., “the elimination of periodic defects which would be visible to the eye” and “limits needed to insure that any defects which are present do not generate coherent scattering or produce visible tool marks”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571)272-1501. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Catherine Simone
Examiner
Art Unit 1772
January 30, 2004



HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

2/5/04